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10/684,281	10/10/2003	Reid F. Hayhow	10030552-1	3341
63448	7590		EXAMINER	
Gregory W. Osterloth Holland & Hart, LLP P.O. Box 8749 Denver, CO 80201			WORJLOH, JALATIE	
			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/684,281  
Filing Date: October 10, 2003  
Appellant(s): HAYHOW, REID F.

Gregory W. Osterloth (Reg. No. 36, 232)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 9, 2009 appealing from the Office action mailed April 21, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

1. Claims 14-19 are rejected under 35 U.S.C. 102(c) as being anticipated by U.S. Patent No. 7191368 to Organ et al. ("Organ").

Referring to claim 14, Organ discloses a tester to apply to one or more testes to a device (see abstract – an electronic tester; a test head is coupled to a device under test), logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license (i.e. rule) (see col. 12, lines 4-6) and to create at least one log file having resources use information for one or more tests executed on the tester (see col. 14, lines 46-50).

Referring to claims 15-18, Organ discloses the system wherein the logic is to enable an amount of memory available on the tester according to one of the properties of the electronic license (i.e. attribute), to enable a speed available on the tester (i.e. timing information) according to one of the properties of the electronic license, to enable a number of waveforms available on the tester according to one of the properties of the electronic license and to enable a number of edge transactions available on the tester (i.e. attribute) according to one of the properties of the electronic license (see col. 12, lines 4-8).

Referring to claim 19, Organ discloses the tester comprises a system-on-a-chip tester (see abstract, lines 1-4).

Referring to claim 20-25, Organ discloses at least one log file having resource use information for one or more tests executed on the tester comprises at least one log file having

resources use information for one or more tests executed on the device tester using the electronic license, wherein the logic is to generate a usage based on the at least one log file (see claim 14 above). Organ does not expressly disclose the use information including the amount of time the tester is used, information on amount of memory used by the tester during testing of the device is maximum amount of memory used by the tester over a predefined period of time, on a speed at which tests are executed by the tester. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in process. The process of creating the log file would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to create a log file including any type of data because the subjective interpretation of the data does not patentably distinguish the claimed invention.

#### **(10) Response to Argument**

2. Appellant argues that “claim 14 recites a system comprising ‘a tester’ and ‘logic, communicatively coupled to the tester’”. Appellant also asserts that “claim 14 also recites some functions that are performed by the logic.” And that Organ fails to teach or suggest that such functions are performed by any element of Organ's apparatus”.

In response, the Examiner notes that the claim as presented is relating to a system comprising a tester and logic. The functional elements of the claim are merely intended use

features, which have been considered but are given little patentable weight<sup>1</sup> because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. In this particular case, Organ's tester performs allocation and rules checking. The Examiner notes that the tester of Organ is capable of checking any type of rules including electronic license. Thus, "the recitation of a new intended use of an old product does not make a claim to that old product patentable". *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)

Additional, it has been held that "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself." *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967). Thus, the way the tester and the logic are being used does not determine patentability.

Further, the Examiner notes that if Appellant intends to rely on the functional elements of the claim, the claims should be written in a format that expresses such aim (e.g. means plus function). The way the claims are written suggest that Appellant is claiming a system and not the functionally elements. Thus, if Appellant believes that the functional elements should be given weight, then these claims are indefinite as being considered hybrid claims. See MPEP 2173.05 (p) II.

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<sup>1</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

Art Unit: 3685

Claim 14. A system comprising:	
A tester	Tester = an electronic tester See abstract and fig. 1 An electronic tester with digital, and analog, and memory test circuitry on a single platform. A test head is coupled to a device under test.
to apply one or more tests to a device; and	Intended use language
logic, communicatively coupled to the tester,	Logic =program Col. 11, 22-34; col.12, lines 4-6 Col. 14, lines 46-50
to enable one or more resources of the tester according to one or more properties of an electronic license and to create at least one log file having resource use information for one or more tests executed on the tester	Intended use language

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although all limitations must be considered, not all limitations are entitled to patentable weight).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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